

**REMARKS/ARGUMENTS**

In response to the Office Action dated December 31, 2003, claims 1, 12 and 13 are amended, claims 6 and 11 are cancelled, and claims 14-23 are added. Claims 1-5, 7-10 and 13-23 are now active in this application. No new matter has been added.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103**

Claims 1-7 and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Freedman (USPN 4,839,829).

Claims 8-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Freedman in view of Markowitz (USPN 5,513,254).

The rejections of claims 6 and 11 are respectfully traversed.

To expedite prosecution, independent claim 1 is amended to delineate “an alteration means for reducing printing fees for the document images based on times required for forming the additional images”, independent claim 12 is amended to delineate “an alteration means for reducing printing fees for the document images based on the selected additional images”, and independent claim 13 is amended to delineate “an alteration means for reducing printing fees for the document images when the additional images are formed”, which subject matter was originally recited in dependent claim 6.

With the amendments to independent claims 1, 12 and 13, it is now clear that the fee for printing document images (namely the charge for the user) is decreased by the addition of additional images.

In the Official Action, the Examiner purports that the concept of the original claim 6 is disclosed in Freedman (col. 10, lines 15-19). Freedman has a description that (i) the cost is calculated based on usage of different printing or publishing equipment and based upon the parameters of differing printing facilities, (ii) the cost is calculated based on time required for printing, and (iii) the insertion of an additional image is intended for the purpose of efficient usage of all pages (col. 10, line 11-14). While it is possible that an increase of the fee in consequence of the increase of cost which occurs when an additional image is involved would be conceivable to a person of ordinary skill in the art from this description, such description provides no basis to presume that a person of ordinary skill in the art would have any realistic reason for decreasing the fee. That is, the concept of "decreasing the charge for printing the document images *by the addition of the additional images*" (emphasis added) is neither described nor suggested by Freedman.

To further expedite prosecution, claim 10 is amended to include the limitation of claim 11, now cancelled, and claims 14-23 are added.

Amended independent claim 10 now requires, *inter alia*, "a control unit for charging fees only to providers of the additional images when the additional image mode is selected at said mode selection unit".

Claim 14, depending from claim 12, adds the limitation that "the alteration means further charges fees to providers of the additional images based on the selected additional images."

New independent claim 15 recites:

An image forming apparatus comprising:  
an image forming unit for forming images on a sheet,  
a selecting unit for selecting between the first print mode for printing only document images and the second print mode for printing the document images and additional images,

a print controller for controlling the image forming unit so as to print images in conformity with the print mode selected by the selecting unit, and

a control unit for placing a charge for printing the document images and, in the case of the second print mode, further charging fees to a provider of the additional images and, in the case of the second print mode, altering the ratio of the charge imposed on the provider of the additional images and the charge for printing the document images, depending on times required for printing the additional images.

Claims 16-20 respectively depend from claim 15. Dependent claim 16 adds “the limitation that the second print mode causes the additional images to be printed in the white space of the document images”, dependent claim 17 adds the limitation that “the second print mode causes the additional images to be printed on the backside of the sheet where the document images are printed”, dependent claim 18 adds the limitation that “the second print mode causes the additional images to be printed on a sheet separate from the sheet where the document images are printed”, dependent claim 19 adds the limitation that “the control unit in the case of the second print mode lowers the ratio of the charge for printing the document images to the charge for the provider of the additional images in accordance with the times required for printing the additional images are longer”, and dependent claim 19 adds the limitation that “the selecting unit is further adapted to select the third print mode for printing only the additional images and the control unit sets the charge for printing the document images at a lower level in the case of the second print mode than in the case of the first print mode and at a lower level in the case of the third print mode than in the case of the second print mode.”

New independent claim 21 recites:

A method for charging a fee in an image forming apparatus for printing images on a sheet comprising:

a step of selecting between the mode for obtaining a printed image exclusively of document images and the second mode for obtaining a printed image having additional images added to the document images; and

a step of charging a first fee to the print of the document images when the first mode is selected and a second fee smaller than the first fee when the second mode is selected.

Claim 22, depending from claim 21, adds the limitation that “a provider of the additional images is charged with a fee when the charging step selects the second mode” and claim 23, depending from claim 22, adds the limitation that “the ratio of the second fee to the charge to the provider of the additional images is decreased in accordance with times required for printing the additional images are longer when the charging step selects the second mode.”

Markowitz discloses an idea of reducing the *expense of communication* (emphasis added) by adding an advertisement in the FAX communication. However, Markowitz has no disclosure of lowering the charge *for printing the document images* by adding the additional images. Furthermore, Markowitz does not have any suggestion of changing the rate of decrease, depending upon the time for printing the additional images.

The idea of charging the provider of the additional images and the idea of changing the proportion of fee in accordance with the time for printing the additional images are neither disclosed nor suggested anywhere in Freedman or Markowitz.

In view of the above, amended independent claims 1, 12 and 13, claims 2-5 and 7-9 depending from amended claim 1, and new claims 14-23 are patentable over Freedman and Markowitz considered alone or in combination. Consequently, the allowance of claims 1-5, 7-10, 12 and 13, as amended, as well as new claims 14-23, is respectfully solicited.

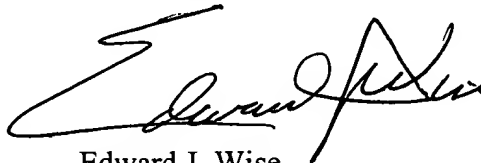
**CONCLUSION**

Accordingly, it is urged that the application, as now amended, overcomes the rejection of record and is in condition for allowance. Entry of the amendment and favorable reconsideration of this application, as amended, are respectfully requested. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY

A handwritten signature in black ink, appearing to read 'Edward J. Wise', is written over a horizontal line.

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